

**REMARKS**

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1-16, 33, and 34 are requested to be cancelled without prejudice.

Claims 1 and 28 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 17-32, and 35-45 are now pending in this application.

**Claim Rejections - 35 U.S.C. § 102**

In section 2 of the Office Action, the Examiner rejected claims 1, 2, 11 and 16 under 35 U.S.C. § 102(b) as being anticipated by Ashitomi et al. (U.S. Patent 5,216,411). Applicants respectfully requested claims 1-16 to be cancelled without prejudice. Accordingly, the rejection under section 102(b) is no longer applicable.

In section 7 of the Office Action, the Examiner rejected claims 1, 3, 4, 17-19, 28, 31, 32, and 38 under 38 U.S.C. § 102(e) as being anticipated by Takahashi (U.S. Patent No. 6,662,244). Applicants respectfully submit that claims 1, 3, and 4 have been cancelled without prejudice.

With regard to independent claim 17, claim 17 recites “a frame; a touch panel coupled to the frame; and a lighting system coupled to the frame and configured to illuminate a display which is separate from the cover when the cover is positioned proximate the display.” Applicants respectfully submit that what is taught in Takahashi is a display 11 configured in a cover 3. Display 11 may be illuminated by a lighting system in cover 11, which is what is referred to in the Examiner’s citation of column 4, lines 12-16 of Takahashi. What is not taught,

however, by Takahashi is that the lighting system is coupled to the frame and is configured to illuminate a display that is not in the cover. The lighting system of Takahashi may be in the cover, but is configured to light display 11 which is part of the cover. Applicants have provided a cover which functions as a touch panel and a lighting system for the display, thereby moving the hardware for the lighting system to the cover instead of having the lighting system in the same body as the display. In the Advisory Action, the Examiner indicated that FIG. 3 has a display which is not part of the cover, however, Takahashi does not disclose, teach, or suggest a lighting system in the cover to illuminate the display 5. Further, because touch panel 11 is inactive when overlaying the display 5 (col. 4, lines 58-67), effectively there is no touch panel in this configuration and it is not useable when overlaying the display. Accordingly, Applicants respectfully submit that independent claim 17 and its respective dependent claims are allowable.

With regard to independent claim 28, Applicants have amended independent claim 28 to include the limitations of claims 33 and 34. Accordingly, because the limitations of claims 33 and 34 have been brought into claim 28, Applicants respectfully submit that claim 28, as presently amended, is not anticipated by Takahashi.

With regard to independent claim 38, independent claim 38 recites “positioning a cover adjacent to at least a portion of a display attached to a computing device, the cover comprising a touch panel and the lighting assembly; illuminating at least a portion of the display; and entering information into the computing device using the touch panel, wherein the cover does not include the display and the cover may be moved out of the way of the display.” Applicants respectfully submit that the cover in Takahashi includes the display. Applicants specifically recite that the cover does not include the display and in particular does not include the display that is being illuminated by the light assembly which is incorporated into the cover. Again, Applicants invention of claim 38 includes a method in which the display is in one housing and the lighting assembly is on the cover. When the cover overlays the display, the lighting assembly illuminates the display. This structure is clearly not taught in Takahashi and therefore the method is neither

taught in Takahashi. Accordingly, independent claim 38 and its dependent claims are therefore allowable.

**Claim Rejections – 35 U.S.C. § 103**

In section 22 of the Office Action, the Examiner rejected claims 5, 6, 8, 9, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Ashitomi et al. in view of Moon (U.S. Patent No. 6,567,137). Applicants respectfully submit that claims 5, 6, 8, 9, and 14 have been cancelled without prejudice.

In section 26 of the Office Action, the Examiner rejected claims 7 under 35 U.S.C. § 103(a) as being unpatentable over Ashitomi et al. in view of Moon as applied to claim 5 and further in view of as applied to claim 5 and further in view of Yamashita et al. (U.S. Published Patent Application No. 2004/0022050). Applicants respectfully submit that claim 7 has been cancelled without prejudice.

In section 28 of the Office Action, the Examiner rejected claims 10 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Ashitomi et al. in view of Aufderheide et al. (U.S. Patent No. 6,555,235). Applicants respectfully submit that claims 10 and 12 have been cancelled without prejudice.

In section 31 of the Office Action, the Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Takahashi. Applicants respectfully submit that claim 15 has been cancelled without prejudice.

In section 33 of the Office Action, the Examiner rejected claims 13, 20, and 39 under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Wilk (U.S. Patent No. 6,643, 124). Applicants respectfully submit that claim 13 has been cancelled without prejudice. Further, Applicants submit that claims 20 and 39 depend from claims 17 and 38 respectfully,

which Applicants believe are allowable. Accordingly, Applicants believe that claims 20 and 39 are also allowable.

In section 35 of the Office Action, the Examiner rejected claims 21, 40 and 41 under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Wilk as applied to claim 20 and 39 above, and further in view of Branson (U.S. Published Patent Application No. 2003/0071832). Claim 21 depends from claim 17 and claims 40 and 41 depend from claim 38. Applicants believe that claims 17 and 38 are allowable and therefore believe claims 21, 40 and 41 also to be allowable. Applicants respectfully submit that claim 33 has been cancelled without prejudice. Further, Applicants respectfully submit that claim 43 depends from claim 38 which Applicants believe is allowable. Accordingly, Applicants believe that claim 43 is also allowable.

In section 39 of the Office Action, the Examiner rejected claims 29 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Agnew as applied to claim 33 and further in view of Moon. With regard to claim 34, Applicants respectfully submit that there is no motivation to combine the teachings of Takahashi, Agnew, and Moon. What is taught by Agnew is a combined touch panel and display light, in that the display light and touch panel are integrated into one piece. This is not what has been invented by Applicants. Applicants have claimed a separate touch panel and a separate display light both integrated into a cover which may illuminate a display on the device body. Further, what is taught in Takahashi is a display having a display light and a touch panel all in a cover. Further, what is taught in Moon is simply a light which illuminates a display, where the display is part of the cover of the device. Accordingly, there is no teaching or disclosure of a display which is part of the device body and a touch panel which is part of the cover with a lighting system that is part of the cover, and when positioned correctly, the lighting system will illuminate the display. The display of Moon is part of the cover and so is the display of Takahashi. The display of Agnew is taught as being part of the device itself. Accordingly, there is no teaching or disclosure in any combination of Takahashi, Moon, and Agnew, which provides all of the claim limitations of claim 28 as amended (formerly claim 34). Further, even if there was a teaching of all of the limitations of

claim 28, there is no motivation to combine the teachings of Takahashi, Moon and Agnew as the problems which are being solved by each of Takahashi, Moon and Agnew are completely different. The teaching of Takahashi is to have a second display which is incorporated into a cover. The teaching of Moon is to have a light source for a reflective display which is part of a cover. The teachings of Agnew is to have a combined touch panel and display light all incorporated into one electronic element. There is no motivation to solve the problem of providing a touch panel and a lighting assembly in a cover which is a touch panel that can be used with the display on the device as well as having a light in the cover which illuminates the display on the device, where there is no display incorporated into the cover itself. Accordingly, Applicants respectfully submit that claim 28, as amended, is therefore allowable. Further, Applicants respectfully submit that claim 29, as depending from claim 28 is also allowable.

Applicants also note that it is understood that a final rejection has been issued by the Examiner, however, Applicants respectfully submit that the amendment to claim 28 be entered as the amendment to claim 28 is nothing more than the inclusion of the claim limitations of claim 33 and 34 into claim 28. Accordingly, Applicants request the entry of the Amendment of claim 28 as claim 28 was previously searched as claim 34.

In section 41 of the Office Action, the Examiner rejected claims 25-27 and 35-37 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Aufderheide et al. Applicants respectfully submit that claims 25-27 depend from claim 17, which Applicants believe is allowable and claims 35-37 depend from claim 28 which Applicants believe is allowable. Accordingly, Applicants believe that claims 25-27 and 35-37 are allowable.

In section 45 of the Office Action, the Examiner rejected claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Branson. Applicants respectfully submit that claim 30 depends from claim 28 which Applicants believe is allowable. Accordingly, Applicants believe that claim 30 is also allowable.

In section 37 of the Office Action, the Examiner rejected claims 22-24, 33, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Agnew (U.S. Published Patent Application No. 2002/0084992). Claims 22-24 depend from independent claim 17. Applicants believe that independent claim 17 is allowable. Accordingly, Applicants believe that claims 22-24 are also allowable.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date January 04, 2005

By Alistair K. Chan

FOLEY & LARDNER LLP  
Customer Number: 26371  
Telephone: (414) 297-5730  
Facsimile: (414) 297-4900

Alistair K. Chan  
Attorney for Applicants  
Registration No. 44,603